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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,934	07/10/2003	John Thomas Stites	005127.00209	9941
22909	7590	04/12/2005	EXAMINER	
BANNER & WITCOFF, LTD. 1001 G STREET, N.W. WASHINGTON, DC 20001-4597			HUNTER, ALVIN A	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,934

Applicant(s)

STITES ET AL.

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-46, 48-67, 69 and 70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-46, 48-67, 69 and 70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/29/04, 3/24/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 12-46, 48-67, 69, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finn (USPN 6514154) in view of Reimers (USPN 5683309).

Regarding claim 1, Finn discloses a golf club having a face **184** that provides a contact area for engaging a golf ball and a weight positioning system that includes a support **202** and a weight **204** wherein the weight being movable along the support and around the support to vary the position of the center of gravity of the club head in at least two directions with respect to the face and securable in at least two positions along and around the support (See Figures 29-32). Based on Figures 31 and 32, it appears the weight is inherently offset from the longitudinal axis of the support. But if in doubt, Reimers discloses a club head having a weight and support. Being that Reimers shows the weight portion being wedge shaped, the center of gravity is clearly offset from the axis of the support (See Column 4, lines 25 through 45). One having ordinary skill in the art would have found it obvious to have the center of gravity offset the longitudinal axis of the support, as taught by Reimers, in order to provide the club head with more eccentric weighting.

Regarding claim 2, Finn shows the club head having a shell wherein the face is a portion of the shell.

Regarding claim 3, Finn show the shell defining an aperture wherein the weight is removable from the interior of the shell through the aperture (See Figure 31).

Regarding claim 4, Finn shows the aperture position in a lower area of the shell (See Figure 28, 29, and 31).

Regarding claim 5, Finn discloses the weighting system including a connector configured to connect the weight positioning system to the shell (See Column 9, lines 35 through 41).

Regarding claim 6, Finn discloses the support positioned in a substantially vertical orientation (See Figure 32).

Regarding claim 7, Finn discloses the weight positioning system including a locking mechanism that secures a position of the weight relative to the support (See Figure 32 and Column 9, lines 27 through 35).

Regarding claim 8, Finn discloses the locking mechanism being a pair of locking rings that extend around the support (See Figure 32).

Regarding claim 9, Finn discloses the support and the locking rings having corresponding threads (See Figure 32).

Regarding claim 10, Finn shows the locking rings positioned on opposite sides of the weight (See Figure 32).

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Regarding claim 12, Reimers discloses the weight may be of any shape. One would have found it obvious to have the weight of any shape, as taught by Reimers, so long as the center of gravity is offset.

Regarding claim 13, Finn discloses the weight defining an opening that extends around the support (See Figure 32).

Regarding claim 14, it is believed that Finn inherently shows the center of gravity of the weight offset from the opening. But if in doubt, Riemers clear discloses the center of gravity of the weight being offset from the opening (See Figures 1 and 6). One having ordinary skill in the art would have found it obvious to have the center of gravity of the weight offset the opening, as taught by Riemers, in order to provide the club head with more eccentric weighting.

Regarding claim 15, Finn discloses protrusions (threads) extending along the support and indentations (threads) position within the opening (See Figure 32).

Regarding claim 16, Finn shows the weight independently movable along the support and independently movable around the support (See Figure 32).

Regarding claim 17, Reimer discloses a scale to determine the position of the weight relative to the support (See Column 4, lines 26 through 45). One having ordinary skill in the art would have found it obvious to incorporate a scale, as taught by Reimers, in order to identify the location of the weighting.

Regarding claim 18-20, Reimers discloses that other disks of different shapes and masses may be employed with the invention (See Column 4, lines 46 to Column 5, lines 1 through 23). One having ordinary skill in the art would have found it obvious to

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have weights of different sizes and shapes, as taught by Reimers, in order to achieved the weight desired by the user.

Regarding claim 21, Reimers discloses a weighting system mounted on the exterior surface of the club head. One having ordinary skill in the art would have drawn from Reimers that the weighting system may be place in either the interior or exterior surface of the club head and would have further drawn from Reimers the placing the weighting system on the exterior surface makes it more accessible than placing it on an interior surface. One having ordinary skill in the art would have found it obvious to have the weight system mounted on the exterior surface of the club head, in order to make the weighting system more accessible to the user.

Regarding claims 22 and 23, Reimers discloses the weight may be of any shape. One would have found it obvious to have the weight of any shape, as taught by Reimers, so long as the center of gravity is offset.

Regarding claims 24 and 30, Finn discloses a golf club having a shell with a face **184** wherein the face is a portion of the shell that provides a contact area for engaging a golf ball and a weight positioning system that includes a support **202** having a longitudinal axis (centerline) that is substantially parallel to the face and a weight **204** wherein the weight being movable along the support and around the support to vary the position of the center of gravity of the club head in a first direction with respect to the face and securable in at least two positions along and around the support (See Figures 29-32). Based on Figures 31 and 32, it appears the weight is inherently offset from the longitudinal axis of the support. But if in doubt, Reimers discloses a club head having a

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weight and support. Being that Reimers shows the weight portion being wedge shaped, the center of gravity is clearly offset from the axis of the support (See Column 4, lines 25 through 45). One having ordinary skill in the art would have found it obvious to have the center of gravity offset the longitudinal axis (centerline) of the support, as taught by Reimers, in order to provide the club head with more eccentric weighting.

Regarding claim 25, Finn shows the weight independently movable along the support and independently movable around the support (See Figure 32).

Regarding claim 26, Finn show the shell defining an aperture wherein the weight is removable from the interior of the shell through the aperture and the aperture positioned in a lower area of the shell (See Figure 28, 29, and 31).

Regarding claim 27, Finn discloses the weight positioning system including a locking mechanism that secures a position of the weight relative to the support (See Figure 32 and Column 9, lines 27 through 35).

Regarding claim 28, Finn discloses the locking mechanism being a pair of locking rings that extend around the support (See Figure 32).

Regarding claim 29, Finn discloses the support and the locking rings having corresponding threads (See Figure 32).

Regarding claim 31, Finn discloses the weight defining an opening that extends around the support (See Figure 32).

Regarding claim 32, it is believed that Finn inherently shows the center of gravity of the weight offset from the opening. But if in doubt, Reimers clear discloses the center of gravity of the weight being offset from the opening (See Figures 1 and 6). One

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having ordinary skill in the art would have found it obvious to have the center of gravity of the weight offset the opening, as taught by Reimers, in order to provide the club head with more eccentric weighting.

Regarding claim 33, Finn discloses protrusions (threads) extending along the support and indentations (threads) position within the opening (See Figure 32).

Regarding claim 34, Reimer discloses a scale to determine the position of the weight relative to the support (See Column 4, lines 26 through 45). One having ordinary skill in the art would have found it obvious to incorporate a scale, as taught by Reimers, in order to identify the location of the weighting.

Regarding claims 35-37, Reimers discloses that other disks of different shapes and masses may be employed with the invention (See Column 4, lines 46 to Column 5, lines 1 through 23). One having ordinary skill in the art would have found it obvious to have weights of different sizes and shapes, as taught by Reimers, in order to achieved the weight desired by the user.

Regarding claim 38, Finn discloses the weighting system including a connector configured to connect the weight positioning system to the shell (See Column 9, lines 35 through 41).

Regarding claims 39 and 40, Reimers discloses the weight may be of any shape. One would have found it obvious to have the weight of any shape, as taught by Reimers, so long as the center of gravity is offset.

Regarding claim 41 and 42, Finn discloses a golf club having an elongated shaft and a head on an end of the shaft wherein the head comprises a shell with a face **184**

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wherein the face is a portion of the shell that provides a contact area for engaging a golf ball and a weight positioning system that includes a support **202** having a longitudinal axis (centerline) that is substantially parallel to the face and a weight **204** wherein the weight being independently movable along the support and around the support to vary the position of the center of gravity of the club head in a first direction with respect to the face and independently movably around the support to vary the position of the center of gravity of the golf club head in a second direction with respect to the face, and a locking mechanism that secures in at least two positions along and around the support (See Figure 28-32 and Column 9, lines 27 through 35) Based on Figures 31 and 32, it appears the weight is inherently offset from the longitudinal axis of the support. But if in doubt, Reimers discloses a club head having a weight and support. Being that Reimers shows the weight portion being wedge shaped, the center of gravity is clearly offset from the axis of the support (See Column 4, lines 25 through 45). One having ordinary skill in the art would have found it obvious to have the center of gravity offset the longitudinal axis (centerline) of the support, as taught by Reimers, in order to provide the club head with more eccentric weighting.

Regarding claims 43 and 44, Finn show the shell defining an aperture wherein the weight is removable from the interior of the shell through the aperture and the aperture positioned in a lower area of the shell (See Figure 28, 29, and 31).

Regarding claim 45, Finn discloses the locking mechanism being a pair of locking rings that extend around the support (See Figure 32).

Regarding claim 46, Finn discloses the support and the locking rings having corresponding threads (See Figure 32).

Regarding claim 48, Finn discloses the weight defining an opening that extends around the support (See Figure 32).

Regarding claim 49, it is believed that Finn inherently shows the center of gravity of the weight offset from the opening. But if in doubt, Reimers clear discloses the center of gravity of the weight being offset from the opening (See Figures 1 and 6). One having ordinary skill in the art would have found it obvious to have the center of gravity of the weight offset the opening, as taught by Reimers, in order to provide the club head with more eccentric weighting.

Regarding claim 50, Finn discloses protrusions (threads) extending along the support and indentations (threads) position within the opening (See Figure 32).

Regarding claims 51-53, Reimers discloses that other disks of different shapes and masses may be employed with the invention (See Column 4, lines 46 to Column 5, lines 1 through 23). One having ordinary skill in the art would have found it obvious to have weights of different sizes and shapes, as taught by Reimers, in order to achieved the weight desired by the user.

Regarding claim 54, Reimers discloses a weighting system mounted on the exterior surface of the club head. One having ordinary skill in the art would have drawn from Reimers that the weighting system may be place in either the interior or exterior surface of the club head and would have further drawn from Reimers the placing the weighting system on the exterior surface makes it more accessible than placing it on an

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interior surface. One having ordinary skill in the art would have found it obvious to have the weight system mounted on the exterior surface of the club head, in order to make the weighting system more accessible to the user.

Regarding claims 55 and 58, Finn discloses a golf club having an elongated shaft and a head on an end of the shaft wherein the head comprises a shell with a face **184** wherein the face is a portion of the shell that provides a contact area for engaging a golf ball and a weight positioning system that includes a support **202** having a longitudinal axis (centerline) that is substantially parallel to the face and a weight **204** wherein the weight being movable in three dimensions with respect to the support to vary the position of the center of gravity of the club head in three dimensions and securable in at least two positions along and around the support (See Figures 28-32). Based on Figures 31 and 32, it appears the weight is inherently offset from the longitudinal axis of the support. But if in doubt, Reimers discloses a club head having a weight and support. Being that Reimers shows the weight portion being wedge shaped, the center of gravity is clearly offset from the axis of the support (See Column 4, lines 25 through 45). One having ordinary skill in the art would have found it obvious to have the center of gravity offset the longitudinal axis (centerline) of the support, as taught by Reimers, in order to provide the club head with more eccentric weighting.

Regarding claim 56, Finn discloses the weight positioning system including a locking mechanism that secures a position of the weight relative to the support (See Figure 32 and Column 9, lines 27 through 35).

Regarding claim 57, Finn discloses the locking mechanism being a pair of locking rings that extend around the support (See Figure 32).

Regarding claim 59, Finn discloses the weight defining an opening that extends around the support (See Figure 32).

Regarding claim 60, it is believed that Finn inherently shows the center of gravity of the weight offset from the opening. But if in doubt, Reimers clear discloses the center of gravity of the weight being offset from the opening (See Figures 1 and 6). One having ordinary skill in the art would have found it obvious to have the center of gravity of the weight offset the opening, as taught by Reimers, in order to provide the club head with more eccentric weighting.

Regarding claims 61 and 62, Reimers discloses that other disks of different shapes and masses may be employed with the invention (See Column 4, lines 46 to Column 5, lines 1 through 23). One having ordinary skill in the art would have found it obvious to have weights of different sizes and shapes, as taught by Reimers, in order to achieved the weight desired by the user.

Regarding claim 63, Reimers discloses a weighting system mounted on the exterior surface of the club head. One having ordinary skill in the art would have drawn from Reimers that the weighting system may be place in either the interior or exterior surface of the club head and would have further drawn from Reimers the placing the weighting system on the exterior surface makes it more accessible than placing it on an interior surface. One having ordinary skill in the art would have found it obvious to have

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the weight system mounted on the exterior surface of the club head, in order to make the weighting system more accessible to the user.

Regarding claims 64 and 65, Finn discloses a golf club having an elongated shaft and a head on an end of the shaft wherein the head comprises a shell with a face **184** wherein the face is a portion of the shell that provides a contact area for engaging a golf ball and a weight positioning system that includes a support **202** having a longitudinal axis (centerline) that is substantially parallel to the face and a weight **204** wherein the weight being movable in three dimensions with respect to the support to vary the position of the center of gravity of the club head in three dimensions and securable in at least two positions along and around the support (See Figures 28-32). Based on Figures 31 and 32, it appears the weight is inherently offset from the longitudinal axis of the support. But if in doubt, Reimers discloses a club head having a weight and support. Being that Reimers shows the weight portion being wedge shaped, the center of gravity is clearly offset from the axis of the support (See Column 4, lines 25 through 45). One having ordinary skill in the art would have found it obvious to have the center of gravity offset the longitudinal axis (centerline) of the support, as taught by Reimers, in order to provide the club head with more eccentric weighting.

Regarding claim 66, Finn discloses the support positioned in a substantially vertical orientation (See Figure 32).

Regarding claim 67, Finn discloses the weight positioning system including a locking mechanism that secures a position of the weight relative to the support (See Figure 32 and Column 9, lines 27 through 35).

Regarding claim 69, Finn shows the weight independently movable along the support and independently movable around the support (See Figure 32).

Regarding claim 70, Reimers discloses the weight may be of any shape. One would have found it obvious to have the weight of any shape, as taught by Reimers, so long as the center of gravity is offset.

Response to Arguments

Applicant's arguments with respect to claims 1-70 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

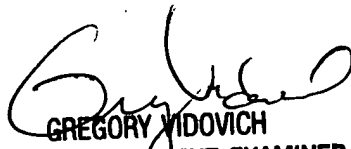
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAH

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